

## REMARKS

### CLAIM REJECTIONS 35 U.S.C. § 102

Without addressing the merits of the 35 USC §102(e) and 35 USC §103(a) rejections, Applicants respectfully request withdrawal of the rejections based on applicant Joshua Buesseler's declaration submitted herewith under 37 C.F.R. § 1.131, establishing the Applicants' invention was conceived and actually reduced to practice prior to the earliest filing date that can be accorded to published U.S. Patent Application No. 2003/0104,791 to Engstrom et al. ("Engstrom").

Before undertaking a substantive review of the facts contained in the declaration, Applicants set forth brief statements of the law pertinent to a declaration swearing behind a reference. Section 715.02 of the M.P.E.P. states that an affidavit or declaration under 37 C.F.R. § 1.131 must establish possession of either the whole invention claimed or something falling within the claim, in the sense that the claim as a whole reads on it.

37 C.F.R. § 1.131 states that the priority of an invention may be shown by any satisfactory evidence of the fact. In general, proof of actual reduction of practice requires a showing that the apparatus actually existed and worked for its intended purpose. (M.P.E.P. § 715.07). The term "reduction to practice" has the same definition under 37 C.F.R. § 1.131 as the term is used in an interference proceeding. "In an interference proceeding, a party seeking to establish an actual reduction of practice must satisfy a two-prong test: (1) the party constructed an embodiment or performed a process that met every element of the interference count, and (2) of the embodiment or process operated for its intended purpose. *Eaton v. Evans*, Fed. Cir., No. 97-1267, as cited in M.P.E.P. § 2138.05. For an actual reduction of practice, the invention must have been sufficiently tested to demonstrate that it will work for its intended purpose, but need not be in a commercially satisfactory state of development.

### **Claims 1-2, 4, 6, 12-13, and 26-29**

Having set forth the appropriate framework for an analysis of whether reduction of practice occurred prior to the critical date of Engstrom, Applicants submit that upon consideration of the facts spelled out in the attached declaration and supported by the evidentiary documents (Exhibit A), the burden to show actual reduction of practice before the critical date of Engstrom has been met and respectfully requests withdrawal of the rejection under 35 U.S.C. § 102(e) for the following reasons. The Claims 1-2, 4, 6, 12-13, and 26-29 have been rejected under 35 U.S.C. § 102(e) as being unpatentable over Engstrom. The earliest effective date of Engstrom is May 17, 2001. As described in more detail below, the attached 37 C.F.R. § 1.131 declaration ("attached declaration"), which are supported by evidentiary materials, establish that subject matter falling within the scope of Claims 1-2, 4, 6, 12-13, and 26-29 was actually reduced to practice on or before May 17, 2001 (the earliest possible date for Engstrom).

Paragraph 2 of the attached declaration establishes that the method defining Claims 1-4, 7, 9-10, 12-14 was reduced to practice at least as early as May 17, 2001. More specifically, a prototype of a shell was produced at least as early as May 17, 2001. The program included providing a response to a request from a wireless device.

As discussed above, the attached declaration establishes that the invention claimed in this application was actually reduced to practice at least as early as May 17, 2001, the earliest filing date that can be accorded to the Engstrom patent, thereby removing this patent as a reference.

### **CLAIM REJECTIONS 35 U.S.C. § 103**

#### **Claim 28**

Having removed Engstrom as a reference, it is clear that Claims 28 is allowable as well since Engstrom is the 35 U.S.C. § 102(e) reference used as a basis to reject Claim 28. Section 715 of the M.P.E.P. states that a rejection using 102(e) art may be overcome by showing completion of the invention by the applicant prior to the effective date of the reference. Therefore, Claim 28 is allowable as well.

### **Obviousness-Type Double Patenting Rejection**

The Office Action dated July 7, 2004, failed to address the Applicants' arguments relating to obviousness-type double patenting. Nevertheless, these arguments have been further clarified below.

Claims 1-2 and 26-29 were rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Design Patent No. D470,135S, to Buesseler et al. (hereinafter "*Buesseler*").

Briefly, the obviousness-type double patenting rejection is improper as it is merely a **one-way** double patenting rejection of the *design patent claims* reading on *the utility patent claims*. As discussed below, the courts have determined that a **two-way** test is appropriate. Thus, assuming, arguendo, that the design patent claims read on the utility patent claim as suggest, the *utility patent claims* do not read on the ornamental aspects of the *design patent claims*. Resultantly, Applicants respectfully submit that the obviousness-type double patenting rejection is improper and that claims 1-2 and 26-29 are patentable over *Buesseler*.

#### **A**

Courts have generally frowned upon using design patents as the grounds for obviousness-type double patenting rejections.

In applying [double patenting tests], there is a heavy burden of proof on one seeking to show double patenting. Double patenting is rare in the context of utility versus design patents. *Carman Indus., Inc. v. Wahl*, 724 F.2d 932, 940; 220 U.S.P.Q. 481 (Fed. Cir. 1983).

Courts correctly recognize that claims to ornamental designs and claims to functional aspects of the same implementation of an invention may vary dramatically in scope, as is the case here. In the rare instance, when a design patent is used in a double patenting rejection, it is proper to, among other things, further determine if the design claimed in the design patent is functional or ornamental.

The proper inquiry for determining functionality of a design is whether the overall appearance of the design is dictated by a utilitarian or

ornamental purpose. ***Such a distinction makes it possible to obtain both a utility patent and a design patent on the same article.*** *Carman Indus.* 724 F.2d at 938-39 (Emphasis Added).

When there are several ways to achieve the function of an article of manufacture, the design of the article is more likely to serve a primarily ornamental purpose. *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 117, 1123 (Fed. Cir. 1993).

Additionally, in order for a design patent to be used in an obviousness-type double patenting rejection against a utility patent, it must pass a two-way double patenting test.

In [cases where a design patent is used in a obviousness-type double patenting rejection], a "two-way" test is applicable. Under this test, the obviousness-type double patenting rejection is appropriate only if the claims of the two patents cross-read, meaning that "the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, and vice versa." *In Re Dembiczak*, 175 F.3d 994, 1002; 50 U.S.P.Q.2D 1614

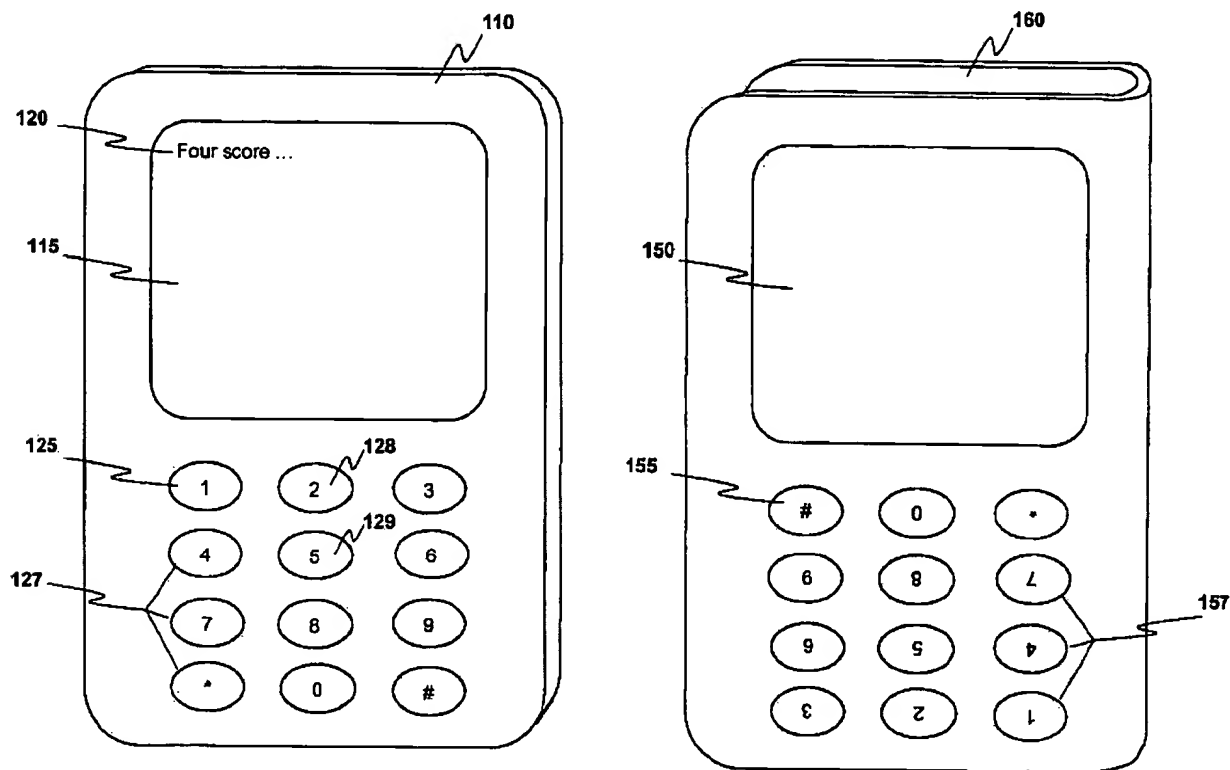
To say that patents cross-read means that a device embodying the patentable design of the design patent *must* infringe the utility patent *and* that a device embodying the patentable claims of the utility patent *must* infringe the design patent. *Carman*, 724 F.2d at 939. (Emphasis in Original)

## B

In regard to the obviousness-type double patenting rejection of Claims 1-2 and 26-29, Applicants respectfully submit that obviousness-type double patenting does not apply between *Buesseler* and Claims 1-2 and 26-29. *Buesseler* merely illustrates the ornamental design for an interchangeable cover of mobile phone. In contrast, the Claims 1-2 and 26-29 of the present application are directed to the functional aspects of a mobile communications device. While the figures of *Buesseler* are similar to the figures in the present applications, *Buesseler's* claim is directed to the ornamental design and aspects as shown in *Buesseler's* figures, i.e., "the visual characteristics or aspect displayed by the article" (MPEP 1502). In contrast, the scopes of Claims 1-2

and 26-29 cover other interchangeable covers not taught, suggested or claimed by *Buesseler* as it is directed to "the way the article is used and works" (MPEP1503).

More importantly the claims of *Buesseler* and claim 1 of the present application cannot be said to cross-read. By way of example, see the following sample drawing A:



DRAWING A

An interchangeable cover 160 as shown in drawing A, comprised of a resilient semi-rigid material, falls squarely within the scope of Claim 1 of the present application:

1. An interchangeable cover for a mobile communications device comprising:

a resilient semi-rigid shell including a front face and back face commonly connected to a side portion and having a substantially U-shaped profile adapted to wrap around a substantial portion of a front, back and side of the mobile communications device upon assembly over the mobile communications device.

However, it is equally clear that the interchangeable cover 160 of Drawing A, whether or not comprised of a resilient semi-rigid material, fails to render obvious the

ornamental design of *Buesseler*. Looking at the interchangeable cover 160 of Drawing A, there is no teaching or suggestion of the visual characteristics or aspect displayed by the interchangeable cover shown in Figures 1-7 of *Buesseler* other than a U-shaped profile. It is clear from these figures that many ornamental aspects of *Buesseler*, (e.g., the curved nature of the cover, the shape and orientation of perforations and/or buttons, the contours, etc.) are not obvious from Claim 1 of the present application. That is, it cannot be said that a device embodying the patentable claims of the utility patent (e.g. claim 1 of the present application) infringes the design patent. Thus the present rejection cannot be said to pass the two-way test as described by the courts.

For the reasons mentioned above, Applicants respectfully assert that Claims 1-2 and 26-29 do should not be rejected under judicially created obviousness-type double grounds. Accordingly, Applicants request that the judicially created obviousness-type double patenting rejection of Claims 1-2 and 26-29 be withdrawn and the claims allowed.

Thus, *Buesseler's* Claim 1 and Claims 1-2 and 26-29 of the present application do not cross-read on each other.

#### **Claims 5, 7-11, 14-25 and 30**

Applicants thank the Examiner for indicating the allowability of Claims 5, 7-11, 14-25 and 30 except for their dependence on a previously rejected base claim.

#### **Claims 31-41**


Applicants also thank the Examiner for indicating acknowledge the allowability of Claims 31-41.

### CONCLUSION

Based on the attached declarations and evidence provided therein, Applicants submit the Engstrom is no longer a viable reference; the double-patenting rejection is improper; and all of the pending claims are now in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (503) 796-2942. If any fees are due in connection with filing this paper, the Commissioner is authorized to charge Deposit Account No. 500393.

Respectfully submitted,  
SCHWABE, WILLIAMSON & WYATT, P.C.

Date: 8<sup>th</sup> Aug 04

by:   
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